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## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of	)	Before the Examiner
Angela J. Keeney, et al.	)	Ellen M. McAvoy
U. S. Serial No. 10/678,468	)	Confirmation Number: 3346
Filed: October 3, 2003	)	Group Art Unit: 1764
HIGH VISCOSITY INDEX WIDE-	)	
TEMPERATURE FUNCTIONAL FLUID	)	Family Number: P2002J112 US2
COMPOSITIONS AND METHODS FOR	)	
THEIR MAKING AND USE	)	

Commissioner for Patents  
P.O. Box 1450  
Alexandria, Virginia 22313-1450

Sir:

AMENDMENTS

All the independent claims have been amended to include a pour point of less than -35°C. The claims now have a novel limitation over copending Application No. 10/678,547. No new matter has been added and support can be found in Paragraph 39 of the specification.

Claims 13 and 21 have been amended to comply with examiner's objection. Applicants respectfully request removal of the double patenting and claim objections based on the amendments.

## CERTIFICATION OF FACSIMILE TRANSMISSION

I hereby certify that this paper is being facsimile transmitted to the  
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*Susan Fleming*  
Signature

March 30, 2007  
Date



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CLAIM REJECTIONS 35 USC 103

The Examiner has rejected the claims for allegedly being obvious over four cited references. Examiner admits, "Applicant's invention differs in independent claims 1, 2, 13 and 14 by including property (c) "a ratio of measured-to-theoretical low-temperature viscosity equal to about 1.2 or less, at a temperature of about -30C or lower, where the measured viscosity is cold-crank simulator viscosity and where theoretical viscosity is calculated at the same temperature using the Walther-MacCoull equation." Examiner then argues, "Although the premium synthetic lubricants of [the references] are not characterized by such values, the examiner is of the position that the claimed functional fluids may be the same as those disclosed in [the references] since the properties of VI and pour point may be the same, and since the claimed functional fluid may be prepared by the same process."

Applicants disagree with examiner that the references disclose a functional fluid with the same properties. The specification teaches a process to obtain fluids with exceptional properties that are not found in the prior art. Applicants have run a sample with the most similar properties to Applicant's invention to demonstrate that the claimed properties are not inherent. The prior art does not disclose the importance of hydrodewaxing with a dewaxing catalyst in combination with the other steps to produce a lubricating oil with the claimed properties. Applicants have submitted an expert affidavit with comparative data to support this argument. The prior art cited by the Examiner is not an enabling disclosure of the invention since a person skilled in the art would not know how to produce a lubricant with the claimed properties without the benefit of Applicant's disclosure. This enablement argument is further supported by the attached affidavit. Applicants have already demonstrated that unless the specific combination of steps is followed the properties may not have the claimed properties.

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There are no known examples of a base stock with the properties being claimed and the specific combination of steps are not taught or suggested in the prior art.

In addition, the prior art does not disclose a functional fluid with a pour point of less than  $-35^{\circ}\text{C}$ . The closest prior art to this limitation has a pour point of less than  $-18^{\circ}\text{C}$  which is significantly higher than  $-35^{\circ}\text{C}$ . In addition, the reference does not disclose any specific pour points near or below  $-35^{\circ}\text{C}$ .

Applicants believe Examiner is applying hindsight reasoning based on the disclosure of the application to argue obviousness. The Examiner is requested to state specifically where in the prior art it teaches the claimed combination of specific steps to achieve the claimed properties or remove the rejection.